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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,487	12/27/2000	John J. Giobbi	MD-1	5898

7590 07/02/2004  
Michael J. Blankstein  
2014 Harrison Street  
Evanston, IL 60201-2222

EXAMINER

JACKSON, JENISE E

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 07/02/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/750,487

Applicant(s)

GIOBBI, JOHN J.

Examiner

Jenise E Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 26-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al. in view of Paget.

3. As per claims 26, 38, 47, Wiser et al. discloses a method of acquiring and playing digital content(see col. 3, lines 5-10), acquiring a physical electronic key(i.e. passport)(see col. 4, lines 15-18) containing key code from a key provider(see col. 4, lines 12-18, fig 1B, sheet 2, ref #110); requesting digital content from a content provider(see col. 4, lines 12-27, 51-67, col. 11, lines 46-48); after locking the digital content with an unlock code associated with the key code contained in the physical electronic key(see col. 5, lines 11-17), receiving the locked digital content(see col. 5, lines 11-17, col. 8, lines 46-53); and entering the locked digital content into a playing device that reads the key code and determines whether the key code is associated with the unlock code, the device being enabled to unlock code(see col. 8, lines 46-56). Wiser does not disclose a physical key being a physical object adapted to be carried by a user apart from the playing device. Paget teaches a physical key being a physical object adapted to be carried by a user apart from the playing device. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a physical key being a physical object adapted to be

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carried by a user apart from the playing device, the motivation is that a digital certificate, paget calls a passport can be installed on the browser or on a smart card(i.e. physical key), that authenticates the card holder, while ensuring confidentiality and integrity of the data users, send, receive and access.

4. As per claim 27, Wiser et al. discloses the step of acquiring the physical electronic key includes providing the key provider with user identification for use by the key provider in establishing a user account, the user account including the user identification information and the key code(see col. 4, lines 13-27, col. 9, lines 25-37).

5. As per claim 28, Wiser et al. discloses including providing the content provider with the key code for use by the content provider in validating the key code prior to providing the locked digital content(see col. 3, lines 37-39, see col. 5, lines 11-17, col. 18, lines 66-67, col. 19, lines 1-25).

6. As per claim 29, Wiser et al. discloses wherein the locked digital content is locked by encryption and unlocked by decryption(see col. 5, lines 12-16, col. 3, lines 37-44, 47-50).

7. As per claim 30, Wiser et al. discloses wherein the step of acquiring the physical electronic key(see col. 3, lines 5-10, col. 4, lines 15-18) includes accessing a first web site of the key provider(see col. 4, lines 12-18, fig. 1B, sheet 2, ref#110) and requesting the physical electronic key via the first web site(see fig. 1B, sheet 2, ref#110, col. 10, lines 18-22), and wherein the step of requesting the digital content includes accessing a second web site of the content provider(see col. 4, lines 12-27, 51-67, col. 11, lines 46-48) and requesting the digital content via the second web site(see fig. 1B, sheet 2, ref #112) .

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8. As per claim 31, Wiser et al. discloses wherein the physical electronic key is acquired at no charge, and wherein the digital content is purchased(see col. 9, lines 20-22).

9. As per claim 32, Wiser et al. discloses a method of managing digital rights(see fig. 1A, sheet 1, ref#108). Further, limitations have already been addressed(see claim 26).

10. As per claim 33, Wiser et al. discloses establishing a user account including user identification information and the key code for the requesting user prior to the step of providing the physical electronic key(see col. 4, lines 13-18).

11. As per claim 34, Wiser et al. discloses obtaining and validating the key code for the requesting user prior to the step of providing the locked digital content(see col. 3, lines 37-39, col. 5, lines 11-17, col. 18, lines 66-67, col. 19, lines 1-25).

12. As per claim 35, Wiser discloses including administering a first web site for receiving a request for the physical electronic key from the requesting user(see col. 4, lines 15-18, fig. 1B, sheet 2, ref#110), and administering a second web site(see fig. 1B, sheet 2, ref#112) for receiving a request for the digital content from the requesting user(see col. 4, lines 12-27, 51-67, col. 11, lines 46-48).

13. As per claim 36, Wiser discloses wherein the locked digital content is locked by encryption and unlocked by decryption(see col. 5, lines 12-16, col. 3, lines 37-44, 47-50).

14. As per claim 38, it is rejected under the same basis as claim 26.

15. As per claim 39, limitations have already been addressed (see claim 33).

16. As per claim 40, Wiser et al. discloses wherein the means for providing the locked digital content to the requesting user includes a web site on the Internet(see col. 3, lines 5-10, col. 5, lines 11-17, col. 8, lines 46-53).

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17. As per claim 41, Wiser et al. discloses wherein the means for providing the locked digital content secures validation of the key code prior to providing the locked digital content(see col. 3, lines 37-39, see col. 5, lines 11-17, col. 18, lines 66-67, col. 19, lines 1-25).

18. As per claim 42, it is rejected under the same basis as claim 33.

19. As per claim 43, Wiser et al. discloses wherein the means for providing the physical electronic key includes a web site on the Internet)(see col. 3, lines 11-14, col. 4, lines 15-18).

20. As per claim 44, limitations have already been addressed (see claim 26).

21. As per claim 45, Wiser discloses wherein the digital content is locked by encryption and unlocked by decryption(see col. 5, lines 12-16, col. 3, lines 37-44, 47-50).

22. As per claim 46, Wiser discloses wherein the physical electronic key and the playing device include means for communicating the key code to the playing device(see col. 8, lines 46-56).

23. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al in view of Hasegawa.

24. Wiser et al. does not disclose wireless communication. However, Hasegawa does disclose wireless communication(see col. 3, lines 22-39). It would have been obvious to one of ordinary skill in the art to combine Wiser with Hasegawa, because Wireless communication can be used without the use of wires or cables.

#### **Response to Amendment**

26. The Applicant states that Wiser does not disclose a physical key itself and requires that the key be a physical object transportable by a user apart from the playing device. Wiser does

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not disclose this new limitation of a physical key itself and requires that the key be a physical object transportable by a user apart from the playing device. The Examiner has relied on Paget for this feature.

**Final Action, Necessitated by Amendment**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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